REMARKS

Status of Claims

The Office Action mailed January 16, 2007 has been received and reviewed. Each of claims 1, 5-12, and 14-20 stands rejected. Claims 16 and 20 are amended. Reconsideration of the present application in view of the above amendment and the following remarks is respectfully requested.

Rejection under 35 U.S.C. §101

The Office rejects claims 8 and 14 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Office contends that a machine-readable medium comprises a modulated signal, which is non-statutory subject matter. Applicant respectfully disagrees.

The Office seems to require an "ipsis verbis" recitation in the claims by interpreting machine readable medium to be an identical equivalent to computer-readable medium. Contrary to the Office's current interpretation, the Manual of Patent Examining Procedure (MPEP) section 2163 (II)(3)(A) counsels that a claim description does not have to be in "ipsis verbis." Further, section 2106 (II)(C) states that USPTO personnel must always remember to use the perspective of one of ordinary skill in the art; claims and disclosures are not to be evaluated in a vacuum.

Applicant submits that one of ordinary skill in the technical arts understands that computer storage medium, which is supported in the specification, and machine readable medium are identical. Machine-readable media is not a nebulous term, but is a term of art that has a rich history in patent literature. A simple search of the Office's patent database produces many published patents with claims directed to machine-readable media. Applicant directs the

Office to the following patent recently issued by Examiner's Bonshock and Bayerl: US 7,117,450 issued on 03 October 2006. In the issued patent, claims are directed to machine readable media. Applicant has not presented a definition of machine readable medium that contravenes its ordinary and customary meaning. Accordingly, for at least the above reasons, Applicant respectfully requests withdrawal of the rejection of claims 8 and 14.

Rejection Under 35 U.S.C. §103(a)

A.) Applicable Authority

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP §2143 through §2143.03. In order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". *See* MPEP §2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id. See also* MPEP §706.02(j) and §2142.

B.) Obviousness Rejections Based on U.S. Patent No. 5,586,237 issued to Baecker et al. (hereinafter Baecker), U.S. Patent No. 6,545,687 issued to Scott et al. (hereinafter Scott), U.S. Patent No. 6,947,959 issued to Gill et al. (hereinafter Gill), and U.S. Patent No. 5,680,558 issued to Hatanaka et al. (hereinafter Hatanaka).

Claims 1, 5-8, 16, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baecker, Scott, Gill, and Hatanaka. As Baecker, Scott, Gill, and Hatanaka, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 1, 5-8, 16, 17, and 20, Applicant respectfully traverses this rejection, as hereinafter set forth.

Independent claim 1 defines a method that is used by a computer having a graphical operating environment. The graphical operating environments provides a collection of items within a container, where the container includes an outer appearance. The method enumerates the items that exist within the container. For each enumerated item within the container, the method determines whether a graphical preview can be generated. A list is generated to identify each item for which a graphical preview can be generated. In turn, the method selects, from the list, a desired number of items to display on the outer appearance of the container based upon a sort criteria, wherein the sort criteria selects the items based upon those items which were most recently modified in some way. The method displays the graphical previews for each of the selected items on the outer appearance of the container, wherein the graphical previews are not folders, and the graphical previews are generated by a thumbnail extractor based on extensions associated with the selected items. The graphical previews are located in a desired location on the outer appearance of the container to enable a computer user to quickly identify the contents of the container without opening the container.

It is respectfully submitted that independent claim 1 is allowable over the cited prior art because all limitations of claim 1 are not taught or suggested. With respect to independent claim 1, Baecker, Scott, Gill and Hatanaka, singularly and in combination, fail to teach or suggest, among other things, (1) generating a list of items for which a graphical preview can be generated, wherein the graphical previews are not folders and the graphical previews are generated by a thumbnail extractor based on extensions associated with the items; and (2) selecting, from the generated list, a desired number of items to display on the outer appearance of a container based upon a sort criteria, wherein the sort criteria selects the items based upon those items which were most recently modified.

The Office concedes that Baecker, Scott, and Gill fail to teach or suggest the claimed generating a list of items for which a graphical preview can be generated, wherein the graphical previews are not folders and the graphical previews are generated by a thumbnail extractor based on extensions associated with the items. However, the Office contends that Hatanaka in combination with Baecker, Scott and Gill discloses the claimed graphical previews for items, which are generated by a thumbnail extractor based on extensions associated with the items. Applicant respectfully disagrees. Hatanaka, at FIG. 10, FIG. 11, and column 1, lines 16-36, column 5, lines 30-50, column 6, line 63-column 7, line 11 teaches that a header associated with a file is processed to determine whether a file is an audio file. If the file does not have an header indicating that the file is an audio file, the file is opened to allow a user to specify portions of the file that should be utilized to create a thumbnail. If the header specifies that the file contains audio data, a waveform is generated to represent the file. Nothing in Hatanaka teaches or suggests a thumbnail extractor that generates graphical previews of the items in a container based

on the extensions associated with each item in a collection items stored in the container having an outer appearance that presents the sorted graphical previews.

Moreover, the Office concedes that Baecker, Scott, and Hatanaka fail to teach or suggest the claimed sorting of graphical previews to display on the outer appearance of a container as defined in claim 1. The Office contends that Gill in combination with Baecker, Scott and Hatanaka discloses the claimed sorting of graphical previews. Applicant respectfully disagrees. Gill at FIG. 10 discloses a query interface that is utilized to formulate search criteria for digital assets. Gill, at column, 17, lines 60-65, column 18, lines 5-10, FIG. 11, and FIG. 20, further discloses a "query palette," which is a results interface that displays the results of the query, which include thumbnail images. Furthermore, Gill, at column 17, lines 5-6, discloses that an accessories feature enables the user to group or sort the query results based on information included in headers associated with the digital assets. Gill, at column 16, lines 10-15 discloses that the header includes date of last modification. However, the "query palette" as disclosed by Gill is not an outer appearance of a container for a collection of items, wherein the outer appearance presents graphical previews of a desired number of items that were recently modified.

Unlike Baecker, Scott, Gill and Hatanaka, the invention of claim 1 requires a thumbnail extractor that generates graphical previews of the items based on the extensions associated with each item. Additionally, the invention of claim 1 expressly requires displaying graphical previews of sorted items on the outer appearance of a container that stores a collection of items, including the sorted items. The combination of Baecker, Scott, Gill, and Hatanaka fail to fairly teach or suggest the claimed thumbnail extractor and the outer appearance of the container in the

manner claimed in claim 1. Accordingly, for at least the foregoing reasons, the obviousness rejection of claims 1 and should be withdrawn.

Dependent claims 5-8 and 17 depend on claim 1 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claims 5-8 and 17 are allowable by virtue of their dependence on claim 1. See, 37 CFR 1.75(c).

Independent claim 16 as currently amended defines a computer system for displaying a collection of content items on a display using a graphical operating environment. The graphical operating environment of the computer system includes a background appearance rendering component for the collection of content items. Additionally, the graphical operating environment includes a graphical preview rendering component for determining if any of the collection of content items can be graphically represented. For content items that can be graphically represented, the graphical preview rendering component sorts the content items and renders graphical previews of the sorted content items that can be graphically represented on a background appearance. Additionally, the graphical preview rendering component displays a textual message in addition to the background appearance and the graphical previews. The graphical operating environment also includes a thumbnail extractor that generates the graphical previews based on the extensions associated with the at least one of any of the collection of content items, wherein the graphical preview are not folders.

It is respectfully submitted that independent claim 16 is allowable over the cited prior art because all limitations of claim 16 are not taught or suggested. With respect to independent claim 16, Baecker, Scott, Gill and Hatanaka, singularly and in combination, fail to teach or suggest, among other things, (1) a thumbnail extractor that generates graphical previews for a collection of content items based on extensions associated with each content item in the

collection; and (2) a graphical preview generator component for sorting content items that can be graphically represented and for rendering graphical previews of the sorted content items on a background appearance.

The Office concedes that Baecker, Scott, and Gill fail to teach or suggest the claimed thumbnail extractor that generates graphical previews for a collection of content items based on extensions associated with each content item in the collection. However, the Office contends that Hatanaka in combination with Baecker, Scott and Gill discloses the claimed thumbnail extractor as defined in claim 16. Applicant respectfully disagrees. Hatanaka, at FIG. 10, FIG. 11, and column 1, lines 16-36, column 5, lines 30-50, column 6, line 63-column 7, line 11 teaches that a header associated with a file is processed to determine whether a file is an audio file. As discussed above, when the header of a file indicates the file is not an audio file, a user specifies portions of the file to utilize as the thumbnail. If the header specifies that the file is an audio file, a waveform is generated to represent the file. Nothing in Hatanaka teaches or suggest the thumbnail extractor as defined in claim 16.

Moreover, the Office concedes that Baecker, Scott, and Hatanaka fail to teach or suggest a graphical preview generator component for sorting content items that can be graphically represented and for rendering the graphical previews of the sorted content items on a background appearance. The Office contends that Gill in combination with Baecker, Scott and Hatanaka discloses the claimed sorting of graphical previews. Applicant respectfully disagrees. As discussed above, Gill at FIG. 10, FIG. 11, FIG. 20, column, 17, lines 5-6 and 60-65, and column 18, lines 5-10, discloses a query interface that is utilized to formulate search criteria for digital assets and a "query palette," which displays results of the query. The query may include a last

date of modification. However, the "query palette" as disclosed by Gill is not a background appearance that presents graphical previews of sorted content items.

Unlike Baecker, Scott, Gill and Hatanaka, the invention of claim 16 requires a thumbnail extractor that generates graphical previews of the items based on the extensions associated with each item. Additionally, the invention of claim 16 expressly requires displaying graphical previews of sorted items on a background appearance. The combination of Baecker, Scott, Gill, and Hatanaka fail to fairly teach or suggest the claimed thumbnail extractor and the background appearance that that presents the graphical previews as claimed in claim 16. Accordingly, for at least the foregoing reasons, the obviousness rejection of claim 16 and should be withdrawn.

Dependent claim 20 depends on claim 16 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claim 20 is allowable by virtue of its dependence on claim 16. See, 37 CFR. 1.75(c).

C.) Obviousness Rejections Based on Baecker, Scott, and Gill.

Claims 9-12, 14, 15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baecker, Scott, and Gill. As Baecker, Scott, and Gill, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 9-12, 14, 15, 18, and 19, Applicant respectfully traverses this rejection, as hereinafter set forth.

Independent claim 9 defines a method that is used by a computer system to display less than all of a collection of content items within a container. The method displays a background appearance for the collection of content items. In turn, the method determines if any of the collection of content items can be graphically represented. When some of the collection of content items can be graphically represented, the method sorts the content items that can be graphically represented based on a sort criteria and the sorted content items are displayed on the

background appearance for the collection of content items. A textual message is also displayed on the background appearance having the sorted content items.

It is respectfully submitted that independent claim 9 is allowable over the cited prior art because all limitations of claim 9 are not taught or suggested. With respect to independent claim 9, Baecker, Scott, and Gill, singularly and in combination, fail to teach or suggest, among other things, (1) sorting content items that can be graphically represented based on a sort criteria to display the sorted content items on a background appearance for the collection of content items.

The Office concedes that Baecker and Scott fail to teach or suggest sorting content items that can be graphically previewed based on a sort criteria to display the sorted content items on the background appearance. However, the Office contends that Gill in combination with Baecker, and Scott discloses the claimed sorting of content times. Applicant respectfully disagrees. As discussed above, Gill at FIG. 10, FIG. 11, FIG. 20, column, 17, lines 5-6 and 60-65, and column 18, lines 5-10, discloses a query interface that is utilized to formulate search criteria for digital assets and a "query palette," which displays results of the query. The query may include a last date of modification. However, the "query palette" as disclosed by Gill is not a background appearance that presents graphical previews of sorted content items that can be graphically represented.

Unlike Baecker, Scott, and Gill, the invention of claim 9 requires displaying graphical previews of sorted content items that can be graphically represented on a background appearance based on a sort criteria. The combination of Baecker, Scott, Gill, and Hatanaka fail to fairly teach or suggest the background appearance that presents the graphical previews as claimed in claim 9. Accordingly, for at least the foregoing reasons, the obviousness rejection of claim 9 should be withdrawn.

Dependent claims 10-12, 14, and 18 depend on claim 9 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claims 10-12, 14, and 18 are allowable by virtue of their dependence on claim 9. See, 37 CFR. 1.75(c).

Independent claim 15 defines a computer system for displaying less than all of a collection of content items on a display using a graphical operating environment. The graphical operating environment of the computer system includes an item collection manager for providing a collection of content items within a container, the container having a background appearance. Additionally, the graphical operating environment includes a container display provider for sorting the collection of content items based on a sort criteria and displaying graphical previews of the sorted content items, without displaying all content items, on the background appearance of the container. The container display provider also displays a textual message on the background appearance of the container to enable a computer user to more easily identify the contents of the container without opening the container.

It is respectfully submitted that independent claim 15 is allowable over the cited prior art because all limitations of claim 15 are not taught or suggested. With respect to independent claim 15, Baecker, Scott, and Gill, singularly and in combination, fail to teach or suggest, among other things, (1) a container display provider that sorts the collection of content items based on a sort criteria to display graphical previews of the sorted items on a background appearance of a container.

As discussed above, the Office concedes that Baecker and Scott fail to teach or suggest the claimed sorting of items within a container and displaying the sorted items on the background appearance of the container. However, the Office contends that Gill in combination with Baecker and Scott teaches or suggests displaying sorted graphical previews on a

background appearance of a container. Applicant respectfully disagrees. Gill merely describes a query palette that provides search results in response to a search query. The query palette is configured to display thumbnails. The query palette includes accessories that may be utilized to group or sort the results based on header information, such as modification time or file name. However, the query palette is not the claimed container having a background appearance as defined in claim 15.

Unlike Baecker, Scott, and Gill, the invention of claim 15 requires a container with a collection of content items that includes a background appearance that presents graphical previews of sorted content items so that less than all of the collection of content items within the container are presented. Based on a sort criteria, the background appearance is rendered to prevent a display of the entire collection of content items on the background appearance of the container. The combination of Baecker, Scott, and Gill fails to teach or suggest the invention of claim 15. Accordingly, for at least the foregoing reasons, the obviousness rejection of claim 15 should be withdrawn.

Dependent claim 19 depends on claim 15 and further defines novel features of the claimed invention. Accordingly, for at least the reasons set for the above, claim 19 is allowable by virtue of its dependence on claim 15. See, 37 CFR. 1.75(c).

CONCLUSION

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated, since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a Petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.88143.

Respectfully submitted,

/Monplaisir Hamilton/

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